

## REMARKS/ARGUMENTS

By this paper, Applicant responds to the Office Action of May 17, 2006 and respectfully requests reconsideration of the application.

Claims 1-52 are now pending, a total of 52 claims. Of the claims not yet allowed, claims 34, 36, 40, 46 and 50 are independent.

### I. Interview Summary

In an interview of July 7, 2006, it was agreed that a declaration stating that Danish '472 could not satisfy several of the underlying prerequisites of § 103(a) would overcome the combination of Danish '472 and the Tannenbaum textbook proposed in the Office Action.

Accompanying this paper is a Declaration of Dr. David R. Levine, which should be satisfactory to establish that the positions stated in the Office Action are incorrect.

### II. Claims 34, 36 and 40

Claims 34, 36 and 40 are discussed in paragraph 4 of the Office Action in the context of Danish '472 and the Tannenbaum textbook. Claims 34 and 36 recite as follows:

34. A method, comprising the steps of:

during execution of a program on a computer, recognizing in hardware a condition in which an instruction is to affect the function to be performed by a second instruction, and in response, setting the processor into single-step mode;  
taking a single-step exception after executing the second instruction, and setting the processor out of single-step mode.

36. A computer, comprising:

hardware designed to recognize a condition rising during execution of an instruction on a computer, in which the instruction is to affect the function to be performed by a second instruction;

hardware and/or software designed to respond to the recognizing by setting a processor of the computer into single-step mode; and

hardware and software designed to respond to execution of the second instruction by setting the computer out of single-step mode.

40. A computer, comprising:

hardware designed to recognize a condition rising during execution of an instruction on a computer, in which the instruction is to affect the execution of a second instruction, wherein the first instruction and second instructions are generated by an instruction decoder in response to a single instruction fetched from a memory;

hardware and/or software designed to respond to the recognizing by setting a processor of the computer into single-step mode; and

hardware and software designed to respond to execution of the second instruction by setting the computer out of single-step mode.

As discussed in the accompanying Declaration of Dr. David R. Levine, the Office Action's understanding of the Danish '472 reference is incorrect in several respects. In particular:

1. It would not have been obvious to modify Danish '472 for implementation in hardware.
2. Danish '472 does not teach "executing" the "next instruction" (the apparent position of the Office Action to correspond to the "second instruction" of the claims). Instead, Danish '472 states that that instruction is "bypassed." Fig. 2, box 3, list item 1.

Because claims 34, 36 and 40 recite limitations absent from the Danish '472 patent, and the Tannenbaum book does not provide correct motivation to modify, claim 34 may be allowed.

### **III. Dependent claims 39, 41, 44 and 45**

Dependent claims 39, 41, 44 and 45 are discussed in ¶¶ 7-10 of the Office Action. These claims are patentable with the independent claims discussed above. In addition, the dependent claims recite additional features that further distinguish the art, and the analysis of the Office Action is faulty, as discussed in Dr. Levine's declaration.

### **IV. New claims 46-52**

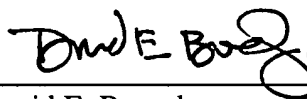
Claims 46-52 are added. They are patentable over the references of record because they recite certain functions implemented in computer hardware. No reference teaches this combination.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. A Petition for Extension of Time extends the non-statutory period for two months. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-29-000125.

Respectfully submitted,

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Dated: October 13, 2006

By: 

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